

REMARKS/ARGUMENTS

Objection:

The specification is objected to because of missing patent application serial numbers. Applicants have amended paragraphs 22 and 27 by adding the missing serial numbers. Withdrawal of the objection accordingly is requested.

Status of Claims:

Claims 9, 10 and 19 have been canceled. Claims 1-8, 11-18 and 20-28 are currently pending, of which claims 1, 7-9, and 11-17 have been amended, and claims 20-28 are new. No new matter has been entered with these amendments.

35 U.S.C. § 112

Claims 7-8 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The movement speed of the first mold part is recited while the claim from which these claims depend recites a movement-preventing means for the first mold part. Applicants have amended claims 7-8 by deleting “first” and substituting therefore, “second”. Recitation of “first” was merely an unintentional typographical error, and therefore, the amendment to claims 7 and 8 does not narrow the scope of any recited feature. Withdrawal of the Section 112 rejection is respectfully requested.

35 U.S.C. § 102

Claims 1, 3-5, 11-13 and 15-16 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hwang (U.S. Pat. No. 4,786,444). Claims 1, 7-11 and 18-19 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Martin et al. (U.S. Pat. No. 5,658,602).

Prior to discussing the prior art based rejections, Applicants believe it useful to discuss a problem they have recognized and a solution to the same. Embodiments of the present invention relate to the assembly of mold parts to form a contact lens. A reaction mixture is first deposited onto a first mold part. A second mold part is then moved into the reaction mixture, and a lens-shaped material is formed between the mold parts. Applicants

discovered that when the second mold part initially moves into the reaction mixture (i.e., begins to be wetted), the first mold part uncontrollably lifts from its resting position towards the second mold part due to a wicking action of the reaction mixture. *See* paragraph 10 for example. This uncontrolled lifting can lead to undesirable results, such as, for example, trapped air in the reaction mixture. *Id.* One solution to this problem, in accordance with preferred embodiments of the present invention, is to employ a movement-preventing means that prevents such lifting of the first mold part towards the second mold part.

Applicants accordingly have amended independent claim 1 to recite that the movement preventing means prevents the first mold part from “being lifted towards said second mold part while said contact lens forming surface of said second mold part is controllably moved into said reaction mixture.” Independent method claim 11 has similarly been amended, albeit in the form of a step. Hwang discloses a mold part support (locating means 17) including an outer sleeve 54 and an inner sleeve 55. Martin discloses pallets 30 that are shaped to receive mold parts. Hwang’s locating means 17 and Martin’s pallet 30 each may prevent lateral and/or downward movement of a mold part containing a reaction mixture. However, neither structure is disclosed or suggested to prevent the mixture-containing mold part from lifting (upward movement) towards a converging mold part as the converging mold part is being wetted by the reaction mixture. Thus, independent claims 1 and 11, and claims depending therefrom, are patentably distinct from Hwang and Martin. In view of the foregoing, reconsideration and withdrawal of the Section 102 rejections are respectfully requested.

35 U.S.C. § 103

Claims 2, 12 and 14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hwang as applied above to independent claims 1 and 11, and further in view of DeRozier et al. (U.S. Pat. No. 5,620,635). Applicants respectfully traverse these rejections.

DeRozier discloses employment of vacuum to hold lens dies 20 and 26 on their respective supports. The examiner asserts that it would have been obvious at the time the invention was made to include a movement preventing means/step that uses vacuum (as taught by DeRozier) to prevent movement of mold part 13 in Hwang. Applicants disagree

because there is no motivation or suggestion to combine these references as suggested by the examiner.

Specifically, there is no motivation or suggestion to modify Hwang as suggested by the examiner because Hwang and DeRozier are directed to distinct lens processes involving different dynamics and potential shortcomings. DeRozier teaches the use of vacuum to hold the dies in place at least prior to injecting thermoplastic lens material into the space between the opposing dies. However, since the lens material is being injected, the material itself applies force to the dies to help hold them against their supports when injected into the space between the dies. Thus, the dies will not lift from their supports when contacted by the thermoplastic material. Hwang, however, is directed to a non-injection process wherein material is deposited onto a first mold part and a second mold part is then placed into the material and converged with the first mold part to ultimately form a lens. Hwang discloses that mold part 13 is held on a shoulder of location means 17 by frictional force, and that this force should be sufficient to maintain the mold part 13 in proper *alignment* (longitudinal axis of mold part 13 is orthogonal to surface 16) during lens manufacture. *See* col. 4, lns. 18-45. There is no disclosure or suggestion that the frictional force will prevent mold part 13 from being lifted towards mold part 12 when mold part 12 is wetted by a reaction mixture located on mold part 13.

Moreover, Hwang does not identify the problem that has been recognized by the Applicants in the present invention – the reaction-containing mold part lifting towards a converging mold part when the converging mold part is wetted by a reaction mixture. And it is improper to use Applicants' specification in hindsight as the sole basis for motivation to combine prior art references.

In view of the foregoing discussion and the discussion in connection with the Section 102 rejections above, Applicants request reconsideration and withdrawal of the Section 103 rejection based on the combination of Hwang and DeRozier.

Claims 6 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hwang as applied to claims 1 and 11 above and further in view of Morland et al. (U.S. Pat. No. 5,114,629). Applicants respectfully traverse this rejection because the combination of the references' teachings would not have produced any claimed invention.

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As stated by the examiner, Morland discloses a process and apparatus for casting a lens using male and female mold halves wherein the male mold full under its own load or weight into the female mold. Claims 6 and 17 do not relate to the weight of the mold parts themselves, but instead relate to adding separate and distinct weights to the first mold part (female mold). *See* paragraph 48 ("[f]urther hold down could be accomplished by using weights over the mold parts"). There is no disclosure or suggestion by Morland to add weights to its female mold to prevent it from lifting towards the male mold. Reconsideration and withdrawal of this Section 103 rejection is therefore requested.

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